

REMARKS

This Amendment and the following remarks are intended to fully respond to the Office Action mailed September 28, 2006. In that Office Action, claims 1-14 and 16-28 were examined, and all claims were rejected. More specifically, claims 1, 2, 4-6, and 8 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Brown et al. (USPN 6,067,551) (“Brown”) in view of Miller et al. (US 2005/0055306) (“Miller”); claim 7 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Brown et al. in view of Miller et al., as applied to claim 5, and further in view of Pham et al. (USPN 6,560,719) (“Pham”); claims 13, 14, 16, and 21-24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Brown et al. in view of Pham et al.; claims 3, 9, and 10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Brown et al. in view of Miller et al., as applied to claim 1, and further in view of Moody et al. (USPN 5,890,177); claims 25 and 26 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Brown et al. and Pham et al., as applied to claim 21 above, and further in view of Moody et al.; claims 11 and 12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Brown et al. in view of Miller et al. and Moody et al., as applied to claim 10, and further in view of Thorne et al. (USPN 5,958,005); claims 27 and 28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Brown et al. and Pham et al. and Moody et al., as applied to claim 25, and further in view of Thorne et al.; claims 17 and 18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Brown et al. in view of Pham et al., as applied to claim 13, and further in view of Moody et al.; and claims 19 and 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Brown et al. in view of Pham et al., as applied to claim 13, and further in view of Thorne et al. Reconsideration of these rejections, as they might apply to the original and amended claims in view of these remarks, is respectfully requested.

In this Amendment, claims 1-5, 8-9, 13, 16-22, and 24-25 have been amended. No claims have been canceled, and no new claims have been added. Therefore, claims 1-14, and 16-28 remain pending for examination.

Brown Does Not, Alone or In Combination with Other References, Make the Currently Amended Claims Obvious.

All of the claims of the present application have been rejected under 35 U.S.C. § 103 as being unpatentable over Brown in light of at least one additional reference. All independent claims 1, 5, 13, and 21 have all been amended to clarify that the claims are directed to a significantly different system and method than disclosed in the cited art, including Brown. For example, claim 1 has been amended to change “determining whether the original document is in use by a second user,” to “determining whether the original document is open at a second user, wherein the second user has exclusive rights to save the original document while the original document is open at the second user” (emphasis added). Similar amendments have been submitted for other elements of claim 1 and for claims 5, 13, and 21. Each of these amendments further distinguishes the claims from the system described by Brown and other cited art, as discussed below. Certain of Examiner’s rejections of claims prior to the current amendments are addressed in a separate section below.

Discussion of Amendments and Cited Art

As stated in previous responses, Brown teaches a method of controlling multi-user editing of a master copy of a document using a multi-user control file (MCF). *See* Brown, at Abstract and col. 2, lines 51-56. The MCF is created on a file server that stores the master copy of the document. *Id.* The MCF is not created on any remote computer. *See* Brown, at col. 4, lines 11-14. The MCF provides access, for remote users, to a local copy of the master copy on the file server. *Id.* The MCF is associated only with the master copy, stored only with the master copy, and is the only process controlling the linking between the master copy on the file server and the local copies used by the remote users. *See* Brown, at col. 5, lines 40-44.

The MCF tracks all versions of the master copy being edited by one or more users. *See* Brown, at col. 2, lines 52-56. In addition, the MCF administers the synchronization of the different versions that have been or are being edited by the different users. *See* Brown, at col. 2, lines 56-65. To accomplish the synchronization, the MCF contains a record for each version of the master copy that is being edited by remote users. *See* Brown, at col. 11, lines 45-48.

The MCF controls save operations from various remote users’ local copies to a master copy resident on the file server. *See* Brown, at col. 12-15. Even the first user to access a document is provided with a local copy, not original document access. *See* Brown, at col. 12,

lines 18-25. When a user initiates a save of edits from its local copy, the MCF is locked, so no other saves can occur until the save operation is completed. *See* Brown, at col. 11, lines 30-41. Once the save operation is complete, the MCF is unlocked so that other users can save edits from their local copies to the master copy on the file server. *Id.* By using a sophisticated central server process like the MCF, Brown is able to permit multiple users to make edits and saves in any order (e.g., the first user to access the document need not be the first person to save edits to the document).

Brown does not, however, disclose “determining whether the original document is open at a second user, wherein the second user has exclusive rights to save the original document while the original document is open at the second user” as required by claim 1 (similar requirements exist in all other independent claims 5, 13, and 21 as well). Nor does Brown disclose taking certain actions “in response to a determination that the original document is open at” another user as stated in various elements of claim 1. *See* claim 1, currently amended. Whether the original document is “open” at a second user is irrelevant in the system disclosed by Brown in terms of what actions are permitted by other users. Brown discloses only determining (e.g., by checking whether the MCF is locked) whether a second user is currently saving edits from its local copy to the master copy. Indeed, the master copy is never “open” because every user, regardless of whether it is the first to seek access to the document at issue, receives only a local copy. No user has exclusive saving rights.

In the claimed system and method, on the other hand, a local copy is opened only in response to a first user determining that a second user already has the original document open. Also, a first user cannot save edits if a second user already has the original document open. This is because the earliest user to request access to the original document is given original document access (exclusive saving rights), and all subsequent users obtain only a local copy and must wait until the earliest user closes the original document before saving changes to the original document. *See* Application page 12, lines 6-27. This is partially what allows the claimed system and method to operate without a central control process (such as the MCF required in Brown).

Similar amendments to other steps in claim 1 have also been made. For example, claim 1 now includes the step of: “in response to the receipt of a request to save changes to the local copy, determining whether the original document is still open at the second user” (emphasis

added). As such the determination of whether the original document is open (or “still open”) at another user is employed in claim 1 both when the “first user” initially requests to open the original document and when the “first user” attempts to save changes made to the local copy. Other steps of claim 1 have been similarly amended, including:

in response to a determination that the original document is ~~in use~~
~~by open at another~~ the second user, creating a local copy and storing a path of the original document with the local copy;

in response to a determination that the original document is not
still ~~in use~~ ~~by open at another~~ the second user, identifying a location for the original document using the stored path and merging the local copy with the original document;

in response to a determination that the original document is still ~~in~~
~~use by open at another~~ the second user, prompting the first user to decide between saving the local copy with the path of the original document such that a subsequent merge of the saved local copy and the original document can be performed, and saving the local copy without the path to the original document.

See claim 1, Currently Amended.

Each of these claim 1 steps references a determination whether the original document is “open at” the second user. As discussed, Brown does not disclose determining whether the original document is “open” at any time because the master copy in the Brown system and method is never “opened” by any user. Only a local copy is opened at each user and no user has exclusive rights to save, which does not meet the limitations of claim 1, as amended. Also, when a local copy in the Brown system is open at second user, there is no effect on what actions a first user can perform. Any user can initiate a save and merge back to the original document at any time, and other users are locked out only during the pendency of actual save operations. By contrast, nearly every element of amended claim 1 involves determining, or responding to a determination, whether the original document is open at a second user.

Claims 5, 13, and 21 include similar amendments relating to a determination whether the original document is “open” at another user (*See*, without limitation, claim 5, currently amended: “in response to a determination that the original document is ~~in use~~ ~~by open at~~ a second user, creating and storing a local copy and storing a path of the original document with the local

copy”; claim 13, currently amended: “a first local document editor of a first user operative to make changes to the original document and to set a flag on the original document, the flag indicating that the original document is ~~in use by~~ open at a the first user”; claim 21, currently amended: “in response to a determination that the original document file is not still ~~in use by~~ open at another the second user, identifying a location for the original document using the stored path and merging the local document file with the original document file.”) Other similar amendments to the independent and dependent claims are apparent by review of the Amendments section herein. Brown does not meet any of these claim elements as amended because, among other reasons, no analogous activity in the Brown system and method is dependent on a determination whether the original document is open at another user.

Claim 13 is further amended to distinguish it more clearly from Brown and the other cited art. Claim 13 now recites a “first local document editor of a first user” and a “second local document editor of a second user.” Unlike the system in Brown, the present embodiments do not require a centralized process like the MCF. Rather, document editors that are local to remote users are employed to, among other things, (a) “set a flag on the original document, the flag indicating that the original document is open at the first user”; and (b) “determine whether the flag is set.” *See* claim 13, currently amended. Moreover, claim 13 requires that “wherein, in response to a determination that the flag is set, the second local document editor is further operative to create a local copy of the original document and to store the document location with the local copy as a registry key associated with the local copy so that a change to the local copy can be merged with the original document at a later time.” *See* claim 13, currently amended.

The Examiner contends that Brown teaches setting “a flag on the original document, the flag indicating that the original document is in use by a first user.” Office Action, September 28, 2006, page 10, paragraph 6 (citing Brown, col. 11, lines 43-50). The cited section of Brown refers to an MCF being created if one does not already exist. It does not involve setting a flag indicating whether an original document is currently open. Nor does Brown teach, in response to the flag being set, using a local document editor to “create a local copy of the original document and to store the document location with the local copy . . . so that a change to the local copy can be merged with the original document at a later time.” Rather, the local copy is created in Brown every time a user attempts to access a document – it is not triggered in response to a flag being set indicating the original document is open elsewhere.

None of the other references cited by the Examiner, alone or in combination with Brown, meet the amended claims either. For example, the Examiner cites Miller. Miller discloses a system for checking documents in and out of a file server. *See* Miller paragraphs 0175-0177. Although a user in the Miller system may need to determine whether a particular document has been “checked out” by another user, Miller does not disclose any way for multiple users to simultaneously edit a document or to merge local copy changes back into an original document. Rather, if a user checks a particular document out, no other user may modify it. *See* Miller paragraph 0181 (“Other users may view the document, but not modify it when it is checked out.”). Accordingly, there is no disclosure or suggestion by Miller for the step of, e.g., “in response to the receipt of a request to save changes to the local copy, determining whether the original document is still open at the second user.” *See* claim 1, as currently amended. Changes made to a local copy are never merged back into the original document, so there would never be a need to determine whether the original document is still open.

Nor, contrary to the suggestion by the Examiner, is there any motivation to combine Miller with Brown. “Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so.” MPEP § 2143.01 ((citing *In re Kahn*, 441 F.3d 977, 986, 78 USPQ2d 1329, 1335 (Fed. Cir. 2006))). Miller teaches away from Brown. Brown is directed to a system wherein a plurality of users can all edit a document at the same time, and a central-server process controls the versions and ensures saves of edits from various local copies are effectively managed. Miller, on the other hand, prohibits edits by anyone except the user that has a document checked out. All other users must wait until after it has been checked back in to check the document out themselves and make any changes. Simply put, Miller is designed specifically to prohibit multiple versions of a document being propagated and later merged, whereas Brown encourages multiple versions of a document to be created and merged by managing a sophisticated central server process. To imply that the combination of Brown and Miller would have been obvious to one of skill in the art to meet the elements of the claims as presently amended could only be rendered from the use of impermissible hindsight gleaned from the benefits of the present application. *See, Ex parte Haymond*, 41 USPQ2d 1217, 1220 (Bd. Pat. App. & Int. 1996).

Discussion of Certain Rejections by Examiner

In addition to the Amendments made above, which were made to more clearly demonstrate the allowability of the claims, Applicants respectfully traverse the rejections made by the Examiner. Applicants concentrate their remarks on certain new cited art and rejections made in the most recent Office Action of September 28, 2006, but preserve previous arguments without prejudice.

For example, previous to current amendments, independent claims 1 and 5 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Brown in view of Miller. The Examiner contends that all elements of claim 1 were met by Brown either explicitly or inherently, except: “prompting the first user to decide between saving the local copy with the path of the original document such that a subsequent merge of the saved local copy and the original document can be performed, and saving the local copy without the path to the original document.” The Examiner contends that Miller teaches this final element of claim 1. Applicants respectfully disagree.

First, Miller does not teach this element. In the Miller system, only the user that checks out a file can edit it. *See* Miller, at paragraphs 0175-0177, 0181. When a file is checked out, other users can download a copy of the file to view it or make changes to it locally, and a “modified version can be uploaded as a new file or different version of a current one” Miller, paragraph 0169. Miller, however, provides no mechanism whatsoever to “prompt the user to decide between saving a local copy with a path to the original document such that a subsequent merge of the saved local copy and the original document can be performed, and saving the local copy without the path to the original document.” Indeed, Miller teaches directly away from this by suggesting that changes made by someone who has not checked out a document must be uploaded as a “new file or a different version of a current one.” *See* Miller, paragraph 169 (emphasis added). There is no suggestion of a system or method of any kind to then merge those changes back into the original file.

Moreover, as discussed above, there is no motivation or suggestion to combine Miller with Brown. If anything, Brown and Miller teach away from each other. Also, as discussed above with respect to the amendments, the other elements of claim 1 are not met by Brown or Miller, alone or in combination.

The Examiner further contends that all elements of Claim 5 are met by Brown either explicitly or inherently, except: (a) “prompting the user to decide whether to merge changes

made to the local copy into the original document” and (b) “periodically determining whether the original document is still ~~in use by~~ open at another the second user” (shown as currently amended). The Examiner contends that Miller teaches these elements of claim 1. Applicants respectfully disagree.

As discussed above, Miller contains no suggestion of a system or method of any kind to then merge local-copy changes back into an original document. Rather, Miller suggests saving any local-copy changes as a new file or a different version. Moreover, Examiner does not provide any support for the assertion that Miller teaches periodically determining whether the original document is still open at another user. Nor is there any suggestion in Miller to periodically determine, for example, whether a particular document is still checked out by another user. It would simply not make sense in Miller to do so since there is no mechanism provided to merge changes in local copies back into an original document anyway. In addition, as discussed above, there is no motivation or suggestion to combine Miller with Brown. Also, as discussed above with respect to the amendments, the other elements of claim 5 are not met by Brown or Miller, alone or in combination.

Claims 13 and 21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Brown in view of Pham. The Examiner admits that Claims 13 and 21 are distinct from Brown because they recite storing a path to the original document as a registry key. However, the Examiner asserts that Pham renders obvious the limitation of storing a path to the original document as a registry key associated with a local copy (see rejection of claims 13 and 21). Applicants kindly submit that the Examiner has not provided the requisite motivation to modify the Brown reference (or any other reference) with Pham to satisfy newly amended claims 13 and 21.

The Examiner’s stated motivation for someone of ordinary skill in the art to combine the Pham reference with Brown is:

It would have been obvious to a person of ordinary skill in the art at the time of the invention to incorporate registry key association with a local copy in the system of Brown because it keeps the user from having to *provide a manual backing-up of the registry keys* every time something is updated. . . .

Furthermore, it saves a considerable amount of time and effort to accomplish the synchronization process.

Office Action (September 28, 2006), page 12, paragraph 1 (emphasis added). Applicants submit that even if someone were motivated to “avoid manual back-up of registry keys,” it does not follow that they would be motivated to store a path to an original document as a registry key associated with a local copy. Moreover, just because Applicants’ suggestion to store the path to the original document as a registry key will save time and effort to merge a local document back into the original document does not mean that it would have been obvious to one of ordinary skill in the art to do so absent the teaching of the present application. In other words, the Examiner’s stated motivation does not lead someone of ordinary skill in the art to the claimed method and system. At best, the stated motivation may lead someone to back up registry keys at a remote computer to synchronize data. *See* Office Action (September 28, 2006), page 11, paragraph 6. Nevertheless, this is not the same as, storing a path of an original document as a registry key of a local copy of the original document.

For at least these reasons, Applicant respectfully requests reconsideration of the rejections to claims 1, 5, 13, and 21 in view of the amendments and arguments set forth herein.

Claims 2-4, 6-12, 14, 16-20, and 22-28 are also patentable over the cited art as these claims depend from claims 1, 5, 13, and 21, and thus recite elements that further distinguish the claims from the cited art.

Conclusion

This Amendment fully responds to the Office Action mailed on September 28, 2006. Still, that Office Action may contain arguments and rejections and that are not directly addressed by this Amendment due to the fact that they are rendered moot in light of the preceding arguments in favor of patentability. Hence, failure of this Amendment to directly address an argument raised in the Office Action should not be taken as an indication that the Applicant believes the argument has merit. Furthermore, the claims of the present application may include other elements, not discussed in this Amendment, which are not shown, taught, or otherwise suggested by the art of record. Moreover, Applicants have made numerous arguments distinguishing the claims from art cited by the Examiner over the course of prosecution of this Application. Although some such arguments are not repeated herein, Applicants respectfully believe such arguments are still applicable to the amended claims and reserves the right to raise

such arguments in future prosecution or appeal. Accordingly, the preceding arguments in favor of patentability are advanced without prejudice to other bases of patentability.

It is believed that no further fees are due with this Response. However, the Commissioner is hereby authorized to charge any deficiencies or credit any overpayment with respect to this patent application to deposit account number 13-2725.

In light of the above remarks and amendments, it is believed that the application is now in condition for allowance and such action is respectfully requested. Should any additional issues need to be resolved, the Examiner is requested to telephone the undersigned to attempt to resolve those issues.

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